

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Dirk Zierer et al.

Application No.: 10/570,643

Confirmation No.: 1224

Filed: March 30, 2005

Art Unit: 1796

For: POLYOXYMETHYLENE MULTI-BLOCK
COPOLYMERS, THEIR PRODUCTION AND
USE

Examiner: D. J. Buttner

RESPONSE TO RESTRICTION REQUIREMENT

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

In response to the restriction requirement set forth in the Office Action mailed December 4, 2009, applicant hereby provisionally elects Group I, claims 1-18, 28, and 30-35 for continued examination, with traverse.

With respect to the elected species, the applicant elects the following:

ABA triblock copolymer,

X = oxygen,

the linking group [between A and X] is diphenyl carbonate [see paragraph no. 0076 of the published specification (general statement is in paragraph no. 0052 of the published specification)],

B is D = polyester,

A is a copolymer of trioxane and dioxolane (see paragraph no. 0042 of the published specification) and

R(4) is – OH. See paragraph no. 0051 of the published specification.

The Examiner has required restriction between:

Group I, claim(s) 1-18, 28 and 30-35, drawn to a block copolymer.

Group II, claim(s) 19-25 and 36, drawn to a method of polymerizing a block polymer.

Applicants respectfully traverse the Restriction requirement because the U.S. Patent and Trademark Office has not carried forward its burden of proof to establish distinctness.

In particular, MPEP § 803 states:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area.

Accordingly, Applicants respectfully traverse the outstanding Election requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

As noted by the Examiner, upon the allowance of a generic claim, Applicant will be entitled to consideration of claims to not more than a reasonable number of species in addition to the elected species, provided that all claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.146.

A five month extension has been paid. Applicant believes no additional fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 03-2775, under Order No. 05587-00400-US from which the undersigned is authorized to draw.

Dated: June 2, 2009

Respectfully submitted,

Electronic signature: /Ashley I. Pezzner/

Ashley I. Pezzner

Registration No.: 35,646

CONNOLLY BOVE LODGE & HUTZ LLP

1007 North Orange Street

P. O. Box 2207

Wilmington, Delaware 19899-2207

(302) 658-9141

(302) 658-5614 (Fax)

Attorney for Applicant